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| 09/829,536 | 04/09/2001 | Shelton Louie | 1205-007/JRD | 8460 |
| 67701 IPSOLON, LLP (JRD) 111 SW COLUMBIA ST. SUITE 710 PORTLAND, OR 97201 | 7590 04/19/2007 | | EXAMINER SHAAWAT, MUSSA A | |
| | | | ART UNIT 3627 | PAPER NUMBER |
| SHORTENED STATUTORY PERIOD OF RESPONSE | | MAIL DATE | DELIVERY MODE | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/829,536

Applicant(s)

LOUIE ET AL.

Examiner

Mussa A. Shaawat

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-10 and 13-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-10 and 13-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Response to Amendment

1. This action is in response to the amendment filed on January 29, 2007. Claims 1, 5, 6, 8-10, 13 and 14 have been amended. Claims 7, 11 and 12 have been cancelled. 1-6, 8-10 and 13-20 are pending examination.
2. Amendment to claims filed on January 29, 2007 does not comply with the 37 CFR 1.121 rules, which applies to amendments filed on or after July 30, 2003. The rule states with respect to currently amended: Claim being amended and which is not withdrawn in the current amendment must include markings (striketthrough, double brackets, or underlining) to indicate changes. In particular applicant amended claim 1 to include the limitation "associating the unique identifier of the tag with customer information stored in a computer system in association with said group of prescription orders", this limitation is suppose to be underlined. For future references applicant is reminded to comply with 37 CFR 1.121 rule when amending the claims.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
4. Claims 1-6 and 8-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 1, the combination of the following steps: (1) grouping said plurality of prescription orders together in a common carrier, (2) automatically and electronically bundling said plurality of prescription orders from the customer together so as to allow them to be identified with the customer, and (3) automatically detecting the prescription orders at the at least one location by sensing the at least one identifying tag attached to the common carrier; are not supported by the original specification. In claim 5, the combination of the following elements: (1) means for grouping the plurality of prescription orders into a common carrier, (2) means for automatically and electronically bundling the plurality of prescription orders from a customer together so as to allow them to be identified with the customer, and (3) said first tag reader able to automatically detect the presence of said tag.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-6, 8-10, and 13-19 rejected under 35 U.S.C. 103(a) as being unpatentable over Denenberg US Pat. No. (6,464,142), in view of Mccullough et al., US Pat.No. (5,974,393), in further view of Markman US Pat. No. (5,794,213), in further view of Engellenner US Pat. NO. (6,057,756) cited in applicants specification as discussed in the previous office action. Further;

Denenberg fails to teach a tag having a unique identifier that is readable by a tag reader in proximity to the tag regardless of its orientation relative to the tag reader.

However Engellenner discloses an electromagnetic tag and tag reader (see col.7 lines 40-65, figure 1) for locating items. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the tag and tag reader of Engellenner in Denenberg et al., because the tag reader of Engellenner can interrogate a larger spatial region.

Although Denenberg et al., teaches grouping a plurality of prescription orders together in a common carrier (see for example the bag Fig. 5B; and col. 10, lines 54-67). Denenberg fails to implicitly teach associating the unique identifier of the tag with customer information stored in a computer system in association with said group of prescription orders.

However, Markman teaches reforming grouped items that comprises the step of automatically and electronically bundling orders from a customer together and associates a unique identifier of the tag with customer information (see for example col.2 lines 52-67, and col.6 line 65-col.7 line 8). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of Markman with the invention of Denenberg to automatically and electronically bundle orders from a customer together and associate a unique identifier of the tag with customer information to easily and efficiently identify the items of each customer.

7. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Denenberg et al., Mccullough et al, Markman, and Engellenner et al as applied to claim

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19 above, and further in view of Yehuda. Denenberg et al., Mccullough et al, Markman, and Engellenner et al teach all of the limitation of the claim except for a display of estimated completion. Yehuda discloses a display (16) that shows an estimated time until completion (see col. 4, lines 44-64). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of Yehuda with the combination of Denenberg et al., Mccullough et al, Markman, and Engellenner et al. to help the customer quickly complete his transaction.

Response to Arguments

8. Applicant's arguments have been fully considered but they are not persuasive.

In particular the applicant argues, A) Regarding the 112 1st rejection, applicants states that the elements of claims 1 and 5 are discussed at length throughout the specification; Elements B) No teaching or suggestion to group the plurality of prescription orders together in a common carrier and to electronically bundle a plurality of prescription orders from the same customer together using the common carrier; C) Denenberg teaches away from automatic tracking of prescription orders; D) Applicant contends that there is no motivation to combine Denenberg et al and Mccullough et al.

In response to A) Claim 1 line 14 states, "***automatically detecting*** ...attached to the common carrier" and claim 5 lines 8 and 11 state "***automatically and electronically bundling...***" "***automatically detect*** the presence of said tag..." these limitations are not described in the specification (*page 10 line 12-page 11 line 28 as pointed out by applicant*) in such a way as to reasonably convey to one skilled in the

relevant art that the inventor(s), at the time the application was filed, had possession of claimed invention. Therefore, the examiner maintains the 112 1st rejection.

In response to B) Denenberg et al., teaches grouping a plurality of prescription orders together in a common carrier (see for example the bag Fig. 5B; and col.10, lines 54-67). In addition Markman teaches a method and apparatus for reforming grouped items that comprises the step of automatically and electronically bundling orders from a customer together and to associated the grouped orders with the identified customer, (see col.2 lines 52-67, and col.6 line 65-col.7 line 8). Therefore, in view of the above evidence the combination of Markman and Denenberg et al., still meet the scope of claimed limitations as currently claimed.

In response to C) The Examiner reminds applicant that "automatic tracking" is not specifically claimed. "Automatically detecting" is claimed and this limitation is well known in the art, as taught by modifying Denenberg in view of Engellenner to include an electromagnetic tag instead of a bar code type tag, would have been within the level of ordinary skill.

In response to D) applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would be

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extremely advantageous to incorporate the teachings of Mccullough et al., into the discloser of Denenberg et al to make the system more efficient. Assigning a unique identification to the prescription, which is used to locate, the customers order and notify the customer of the order status (see Mccullough et al, col.3 lines 31-38, and col.6 line 53-col.7 line 25), one will be able to retrieve the prescription for the customer as quickly as possible. Therefore, in view of the above evidence, Mccullough and Denenberg et al., still meet the scope of the limitations as currently claimed.

Contact Information


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mussa A. Shaawat whose telephone number is 571-272-2945. The examiner can normally be reached on Mon-Fri (8am-5: 30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mussa Shaawat
Patent Examiner
April 09, 2007


F. RYAN ZEENDER
SUPERVISORY PATENT EXAMINER